

I. Applicant Respectfully Requests that the Examiner Provide a More Clear Understanding for the Basis of the Rejection of the Claims

It is difficult to discern the portions of the cited reference that the Examiner relies upon to support the rejection under 35 U.S.C. § 103(a). For example, the Office Action cites to a long string of passages in Kaehler to support the rejection of claim 21. *See* Office Action, page 2 (citing “column 39 lines 28-36 and column 12 lines 28-64 and column 7 lines 1-10 and column 19 lines 3-67 and column 15 lines 14-28 and column 17-18 lines 1-67 and fig: 9” as the basis for the rejection of each limitation). This is not the sort of limitation-by-limitation analysis that is required by the MPEP.

Section 2143.03 of the MPEP requires the “consideration” of every claim feature in an obviousness determination. To render claim 21 unpatentable, however, the Office must do more than merely “consider” each and every feature for this claim. Instead, the asserted combination of the patents to Kaehler and Dahm must also teach or suggest *each and every claim feature*. *See In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (emphasis added) (to establish *prima facie* obviousness of a claimed invention, all the claim features must be taught or suggested by the prior art). Indeed, a proper obviousness determination requires that an Examiner make “a searching comparison of the claimed invention - *including all its limitations* - within its teachings of the prior art.” *See In re Wada and Murphy*, Appeal 2007-3733, *citing In re Ochai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis in original). “In rejecting claims for want of novelty of obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, *the particular part relied on must be designated as nearly as practicable.*” *See* MPEP § 1.104(c)(2) (emphasis added).

In the event of continued rejection over the art of record, Applicant respectfully requests that Examiner provide sufficient detail, as required by the MPEP, to assist Applicant in understanding how the cited references teach or suggest *each and every claim feature* of the pending claims.

II. The Rejection of the Claims Under 35 U.S.C. § 103(a) is Improper and Must be Reversed

Kaehler and Dahm (1) fail to teach and every claim limitation and (2) fail to establish a *prima facie* case of obviousness for claim 21 rejected under 103.

Independent claim 21 recites, in part, “electronically enrolling a user into the transaction processing program.” As acknowledged by the Office, “Kaehler fails to explicitly teach electronically enrolling a user.” *See* Office Action, page 2. The Office Action relies on Dahm to teach this limitation. However, Applicant respectfully submits that the Office Action does not present a proper rationale to combine the references to achieve the claimed system and method, and thus has failed to set forth a *prima facie* case of obviousness. Specifically, modifying the primary reference to include the features of the secondary reference would not have been obvious because the modification would represent classic **impermissible hindsight**.

The Office Action asserts that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of Kaehler to include electronically enrolling a user taught by Dahm in order to provide mobile subscribers who have been identified as being likely candidates for churning, to efficiently, visually and interactively, review an offer for a mobile service plan better meeting subscriber’s needs.” *See* Office Action, pages 2-3. But the Office Action merely *assumes* the combination recited in the claim would be desired. For example, the Office asserts that the combination would provide these performance advantages even though nothing in the prior art, taken as a whole, suggests this desire or advantage.

Specifically, the Office Action assumes that it would have been obvious to one of ordinary skill in the art to use a method and system of providing retention techniques to mobile telephone customers with Kaehler's fuel dispensing system using a transponder. "In order to rely on a reference as a basis for rejection of the applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1447, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). Here, The Office Action fails to explain *why* the art as a whole would suggest use of retention technique for mobile telephone customers in Kaehler's system, which has nothing to do with mobile telephone contracts, let alone providing "subscriber loyalty and retention techniques" to provide a mobile service plan to meet a subscriber's needs. Accordingly, Appellants submit that Kaehler and Dahm are nonanalogous art. None of the cited reference, nor the Office Action, provide any basis for combining a fuel dispensing system using a transponder with a mobile telephone subscriber loyalty and retention technique. Thus, Appellants submit that the Office's assumption is clearly improper.

Applicant further submits that the Office Action's assertion of obviousness is lacking in *evidence*. Instead, the Office Action improperly relies on its own hindsight conjecture that it would have been obvious to modify the teaching of "Kaehler to include electronically enrolling a user taught by Dahm to provide mobile subscribers who have been identified as being likely candidates for churning..." *See* Office Action, page 3. This statement is wholly unsupported by the references. The reasons for obviousness cited by the Office Action to combine the references is nowhere to be found in either Dahm or Kaehler. Even assuming that the rationale is applicable — and it is not — Kaehler provides no suggestions that it would benefit from the teachings of Dahm, specifically the use of telephone subscriber loyalty techniques, or *how* that would work to

achieve the claimed invention. For example, Kaehler is concerned with a fuel dispensing system using a transponder. Dahm, on the other hand, is primarily concerned with a system for providing telephone subscribers an offer using the display and interface of a mobile device. *See* Dahm, Abstract. There is absolutely no teaching or suggestion in either reference to provide one of ordinary skill in the art to combine it with the other. As a result, Applicant respectfully submits that the combination of the primary reference and the secondary references would not have been obvious to one of ordinary skill in the art at the time of the invention.

Under 35 U.S.C. § 103, the Patent Office bears the burden of establishing a prima facie case of obviousness. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). There are four separate factual inquiries to consider in making an obviousness determination: (1) the scope and content of the prior art; (2) the level of ordinary skill in the field of the invention; (3) the differences between the claimed invention and the prior art; and (4) the existence of any objective evidence, or “secondary considerations,” of non-obviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); *see also KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007). An “expansive and flexible approach” should be applied when determining obviousness based on a combination of prior art references. *KSR*, 127 S. Ct. at 1739. However, a claimed invention combining multiple known elements is not rendered obvious simply because each element was known independently in the prior art. *Id.* at 1741. Rather, there must still be some “reason that would have prompted” a person of ordinary skill in the art to combine the elements in the specific way that he or she did. *Id.*; *In re Icon Health & Fitness, Inc.*, 496 F.3d 1374, 1380 (Fed. Cir. 2007). Also, modification of a prior art reference may be obvious only if there exists a reason that would have prompted a person of ordinary skill to make the change. *KSR*, 127 S. Ct. at 1740-41.

For the reasons set forth above, the Office Action has failed to set forth a *prima facie* case of obviousness. For at least the reasons discussed above, the obviousness rejection for claim 21 is improper and should be withdrawn. All other pending claims are also rejected under 35 U.S.C. § 103(a) based on the combination of Kaehler and Dahm. Applicant respectfully submits that the rejections of such claims is also improper for the same reasons as discussed above.

CONCLUSION

In view of the foregoing, it is respectfully submitted that this application is now in condition for allowance. If the Examiner believes that prosecution and allowance of the application will be expedited through an interview—whether personal or telephonic—the Examiner is respectfully invited to telephone the undersigned with any suggestions leading to favorable disposition of the application.

Prompt and favorable consideration of this Amendment is respectfully requested. It is believed that all necessary fees are being charged for filing this Response. However, the Director is hereby authorized to treat any current or future reply, requiring a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. Applicant also authorizes the Director to charge all required fees, fees under 37 C.F.R. § 1.17, or all required extension of time fees, to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

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